



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,163	09/01/2000	Hiroshi Mikitani	KAK-001	5466

23353 7590 07/20/2005

RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3639

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,163

Applicant(s)

MIKITANI ET AL.

Examiner

Igor Borissov

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8-13,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8-13,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 5/04/2005 has been entered.

Response to Amendment

Amendment received on 5/04/2005 is acknowledged and entered. Claims 5, 7, 14 and 15 have been canceled. Claims 1-4 and 8-13 have been amended. New claims 16 and 17 have been added. Claims 1-4, 6, 8-13, 16 and 17 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claim 8, the Claim is indicated as being dependent on Claim 8, which is confusing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6, 8, 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US 5,794,219) in view of Sarno (US 6,024,641).

Brown teaches a system for conducting an on-line auction with bid pooling, comprising:

As per claims 1 and 16, means for allocating an electronic mail address to each of a plurality of specified participants (C. 6, L. 9-16); means for sending an electronic mail in which a unique access key is affixed to said one of a plurality of specified participants (C. 5, L. 55-67); means for recognizing an application for a lottery on the basis of said unique access key obtained via a receiving an electronic mail from each of said participants (C. 6, L. 42-52); and means for notifying participants of the result of the auction (C. 8, L. 41-43).

Brown does not explicitly teach that said means for notifying participants of the result of the auction include means for notifying participants of a result of a lottery.

Sarno teaches a system for lottery gaming, wherein participants are notified of a result of a lottery (C. 6, L. 6-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown to include that the participants are notified of a result of a lottery, as disclosed in Sarno, because it would advantageously allow the participants to learn whether they won the lottery, or not.

As per claim 3, Sarno teaches said system wherein the result of

said lottery is presented before said electronic mail is sent (C. 6, L. 6-17). The motivation to combine Brown with Sarno would be to announce the results to stimulate non-participants to join the lottery.

As per claim 4, Sarno teaches said system wherein a discrimination of the application for said lottery is performed by use of said access key and a destination mail address of said electronic mail (C. 2, L. 49-63; C. 5, L. 30-44). The motivation to combine Brown with Sarno would be to enhance the security of the system.

As per claim 6, Sarno teaches said system and method wherein the result of said lottery is performed by notifying a URL of a page informing the result and an access keyword, using an electronic mail (C. 6, L. 14-17). The motivation to combine Brown with Sarno would be to advantageously allow the participants to learn whether they won or not.

As per claim 8, Sarno teaches said system and method wherein the URL of the page informing said result is separated into one for a winner of a prize and the other for a loser in winning the prize (Figs. 3B, 6; C. 6, L. 14 – C. 7, L. 32). The motivation to combine Brown with Sarno would be to simplify reading of the lottery results.

As per claim 9, Sarno teaches said system and method wherein by entering said access keyword and a mail address to which said access keyword is sent into the page informing said result, a page for the winner of the prize and a page of the loser in winning the prize can be accessed (C. 6, L. 14 – C. 7, L. 32). The motivation to combine Brown with Sarno would be to simplify the access to the results of the lottery.

As per claim 12, Brown teaches said system wherein data of said participant who applied for the lottery is collected and stored (C. 6, L. 2-52).

As per claim 13, Brown teaches said system and method wherein said lottery system is incorporated into a computer system (C. 6, L. 2-52).

As per claim 17, Brown teaches a method for conducting an on-line auction with bid pooling, comprising:

means for allocating an electronic mail address to each of a plurality of specified participants (C. 6, L. 6-16); means for sending an electronic mail in which a unique access key is affixed to said one of a plurality of specified participants (C. 5, L. 55-67);

means for recognizing an application for a lottery on the basis of said unique access key obtained via a receiving an electronic mail from each of said participants (C. 6, L. 42-52); and means for notifying participants of the result of the auction (C. 8, L. 41-43).

Brown does not explicitly teach that said means for notifying participants of the result of the auction include means for notifying participants of a result of a lottery. Brown also does not specifically teach that said means for allocating an electronic mail address to each of a plurality of specified participants include means for allocating a URL to each of said plurality of specified participants; and that said URL is affixed to each email.

Sarno teaches means for sending to each participant a URL of a page via electronic mail, wherein said page holds the result of said lottery as well as an access keyword (C. 6, L. 14 – C. 7, L. 32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown to include that the participants are notified of a result of a lottery by accessing a web page, as disclosed in Sarno, because it would advantageously allow the participants to learn whether they won the lottery, or not from different locations.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Sarno and further in view of Petrecca (US 6,409,593).

As per claim 2, Brown and Sarno teach all the limitations of claim 2, except that said result of said lottery is obtained by a drawing performed when said participant applies for said lottery.

Petrecca teaches a system for drawing for winners over the Internet, wherein a result of a lottery is obtained by a drawing performed when a participant applies for the lottery (C. 4, L. 45-57).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown and Sarno to include that said result of said lottery is obtained by a drawing performed when said participant applies for said lottery, as

disclosed in Petrecca, because it would advantageously stimulate customers to play more often.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Sarno and further in view of Kamasaka et al. (US 6,240,455)

As per claim 10, Brown teaches said system for conducting an on-line auction with bid pooling, comprising:

means for allocating a unique access key (C. 5, L. 55-67); means for sending an electronic mail in which a unique access key is affixed to said one of a plurality of specified participants (C. 5, L. 55-67); means for recognizing an application for a lottery on the basis of said unique access key obtained via a receiving an electronic mail from each of said participants (C. 6, L. 42-52); and means for notifying participants of the result of the auction (C. 8, L. 41-43).

Brown does not explicitly teach that said means for notifying participants of the result of the auction include means for notifying participants of a result of a lottery. Brown also does not specifically teach that said access key is a keyword to be entered in said URL of a page.

Sarno teaches means for sending to each participant a URL of a page via electronic mail, wherein said page holds the result of said lottery as well as an access keyword (C. 6, L. 14 – C. 7, L. 32).

Kamasaka teaches a system for alteration of link destination wherein an access key is a keyword in a URL of a page for application (Figs. 14 and 17; C. 10, L. 29 – C.12, L. 27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown to include that the participants are notified of a result of a lottery by accessing a web page, as disclosed in Sarno, because it would advantageously allow the participants to learn whether they won the lottery, or not from different locations. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown and Sarno to include that said

access key is a keyword in a URL of a page for application, as disclosed in Kamasaka, because it would advantageously simplify the interaction with the system.

As per claim 11, Sarno teaches said system wherein said keyword is a destination of said electronic mail (C. 2, L. 49-63; C. 5, L. 30-44). The motivation to combine Brown with Sarno would be to simplify the interaction with the system.

Response to Arguments

Applicant's arguments filed 5/4/2005 have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art does not teach *allocating an electronic mail address to each participant*, it is noted that Brown teaches said system, wherein the account creation computer transmit a bidder identification number in a new account confirmation message (e-mail) (C. 5, L. 65-66); said bidder identification number is used by the participant to submit bids (to access the system) (C. 7, L. 50-52). Furthermore, Brown specifically teaches an electronic mail server capable of generating a bidder registration message (C. 6, L. 6-16).

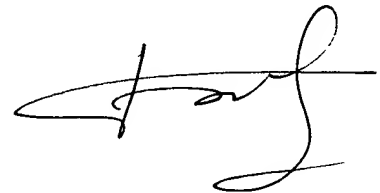
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3639

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igor Borissov
Patent Examiner
Art Unit 3639

A handwritten signature in black ink, appearing to read 'Igor Borissov', with a stylized, flowing script.

IB

7/12/2005